

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

ROBERT M. HERRIN

Serial No. **10/721,962**

Filing Date: **11/25/2003**

For: **TRAY FORMING APPARATUS**

Examiner: **Christopher R. Harmon**

Art Unit: **3721**

Attorney Docket No. **7703.26**

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Responsive to the Office Action of November 8, 2007 (Paper No./Mail Date 20071031), and in connection with the Notice of Appeal filed concurrently herewith, please consider the remarks set out below.

REMARKS

Applicant respectfully requests a Pre-Appeal Conference Panel reconsider and withdraw the Examiner's rejections of Claims 1-6,8, 10-19, 48-52 and 55-56 under 35 USC §102(b) and 7, 9, 53-54 and 57-58 under 35 USC §103(a). This request for a pre-appeal conference is appropriate because the rejections made by the Examiner are erroneous under the applicable law.

I. The Claimed Invention

Claim 1 is directed to an apparatus (100) for folding a paperboard blank (200) into a fully formed tray (202), and comprises a platen 102) for moving the blank (200) through a forming rail (114) for folding portions the blank (200) into a partially formed tray (206). A first folding arm (120) is positioned for biasing against an extended portion (208) of the partially formed tray (120) for a continued folding (see FIG. 4). A fixed plate

(124) and a compression plate (122) are in a spaced relation (see FIG. 10) to form a passage (126) between them. A second folding arm (128) is movable through the passage (126) and positioned for biasing against an extended portion (244) of the partially formed tray (see FIG. 10) for folding the extended portion (244) through the passage (126). The fixed plate (124) guides the extended portion (244, 245) along a surface (125) of the fixed plate (124) onto a tray wall (212, 218) for providing the fully formed tray (202).

Claim 57 depends from Claim 1 and recites the first and second folding arms (120, 128) being rotatable about first and second axes of rotation (120A, 128A), wherein the first axis (120A) is perpendicular to the second axis (128A). See FIG. 12, Replacement Sheet 7/10.

Claim 6 depends from Claim 1 and recites that the platen (102) is further limited by having a fixed peripheral portion (see FIGS. 3 and 9) dimensioned for folding a bottom panel (210) of the blank (200) into a preselected fixed shape.

Claim 11 depends from Claim 1 and recites a locking arm (168) operable with the forming rail (114) for securing the partially formed tray (206) in a second position (see FIGS. 4 and 10).

Independent Claims 8 and 48 and 51 are directed to an apparatus for folding a flat paperboard blank into a tray.

II. The Claims Are Novel under 35 USC §102

The Examiner rejected independent Claims 1, 8, 48, and 51 over US Patent No. 3,978,774 to Royal. Royal discloses a tray forming machine having a mandrel (40) having side walls (54a) and compression plates (54) (that are moveable with respect to a base plate (52) in order to allow the mandrel (40) to be removed from a fully formed tray as a result of portions (shoulder panel 17) of the tray extending over the mandrel (40) thus preventing it from being withdrawn from the formed tray unless the mandrel (40) is reduced in size to fit within inside dimension of the tray (see Col 4, lines 41, 50 and 57). As illustrated in FIGS. 6 and 7 of Royal, the compression plates (54) and

parallel plates (74) form what the Examiner considers to be a "passage" equivalent to the passage (126) of Applicant's independent claims.

Further, the Examiner identifies (see 11/08/2007 Office Action Page 2, Par 3) the compression arms (80), illustrated in FIG. 4 of Royal to be equivalent to the first and second folding arms (120, 128) of the claimed invention which arms (120, 128) include the limitation of being movable through the passage (126) for folding the extended portion (244) of the partially formed blank (206) into the passage (120), where as above described has the fixed plate (124) positioned for guiding the extended portion (244, 245) along its surface (125).

Royal is deficient in that it does not describe the interacting structure of a folding arm movable into a passage. In clear contrast to the specific language of Claim 1, the Examiner takes the position that the compression arm (82) of Royal is movable into the passage formed by the opposing compression plate (54) and parallel plate (74). Clearly, this is not the case.

Applicant's specification clearly defines a "passage" wherein a fixed plate (124) is carried in a spaced relation to the compression plate (122) to form a passage (126), and a second folding arm (128) is carried by the frame (112) and positioned for pivoting and biasing against the extended portion (208) of the partially formed tray (206) for folding the extended portion through the passage (126). See Par 29. Those of ordinary skill in the mechanical arts appreciate that the arms (80) of Royal do not move through the passage formed by the opposing compression and parallel plates (54, 74). Further, Royal does not intend for the arms (80) to operate in such a manner for if they did, the tray would be destroyed in its making by forcing the shoulder (17) to extend further than intended.

The Examiner cites crank arm (88) of Royal (see FIG. 4) as being equivalent to the Applicant's locking arm (167). However, the crank arm (88) acts to operate the compressor arms (80, 82) to hold the tray in place. The locking arm (168) of the claimed invention is a distinctly different and an additional element to the folding arms (120, 128). It appears the Examiner is impermissibly using the Royal element (80) to argue that Royal anticipates the claimed invention calling for folding arms (120, 124)

and a locking arm (168). Royal is deficient in that it does not describe first and second folding arms interacting with a locking arm as called for in Claim 11.

While the Examiner gives no credit (See 11/08/2007 Office Action, Page 5, Line 8 by way of example) to the blank (workpiece 200) with regard to distinguishing the claimed invention over the prior art, the Examiner uses the workpiece (10) of Royal to support his view regarding the teachings of Royal. (See Continuation Sheet Advisory Action 12/05/2007 where Examiner states that a passage is taught by Royal through which the product travels. Additional statements made with this Continuation Sheet lead Applicant to believe that the Examiner does not recognize the distinguishing features of the claimed invention, noting that the movement of the compression plate is not the issue. One distinguishing feature includes the movement of the second folding arms (128) into the passage, not over it or along side it as taught by Royal.

The Examiner rejected Claim 57 depending from Claim 1 under 35 USC 103(a) based on the teachings of Royal and Official Notice regarding the structural arrangement of the first and second folding arms and their axes of rotation being perpendicular to each other arguing that it would have been obvious to one of ordinary skill in the art to provide such a mechanical connection in the invention of Royal in order to prevent interference with the advancement of the next product. The Examiner has not only modified the apparatus of Royal such that it would not operate but has added reasons for making the modification that are not consistent with the teachings of the claimed invention. It would therefore appear that the claimed invention has not been made clear to the Examiner, nor does he appear to understand the problem in the art to which the claimed invention addresses.

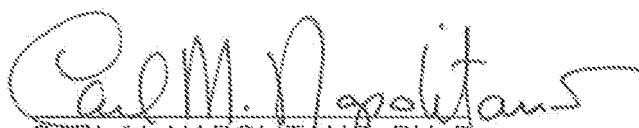
Applicant and undersigned appreciate that the Examiner was willing to grant a brief telephone interview with the undersigned on 12/06/2007 and it is here that the Examiner suggested this Pre-Appeal request for further consideration of the arguments possible avoiding the need for an Appeal Brief. Further, the Applicant does not disagree with the interpretation of the Examiner regarding the passage of Royal, but with the interacting structure of the claimed invention having folding arms and a passage clearly distinguishing over Royal. It appears the Examiner identifies element

within the art without regard to the relationship between the elements as claimed. Therefore, the prior art as cited by the Examiner does not anticipate the claimed invention as required by 35 USC §102.

Further, a person of ordinary skill in the art would not appreciate the necessary modifications to Royal, as suggested by the Examiner, to produce the claimed invention. Indeed, Royal directs his invention to requiring movable side plates to the mandrel in order to fold the tray as desired and allow the mandrel to be reduced in size in order to remove it from the formed tray. Clearly, teaches away from the dimensionally fixed platen of the claimed invention.

Applicant respectfully requests the Pre-Appeal Conference Panel withdraw the Examiner's rejections of Claims 1-6, 8, 10-19, 48-52 and 55-56 under 35 USC §102(b) and 7, 9, 53-54 and 57-58 under 35 USC §103(a).

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Carl M. Napolitano", with a long horizontal flourish extending to the right.

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